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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,997	01/13/2006	Tatsusro Nagahara	2003JP314	6121

26289 7590 11/20/2007

AZ ELECTRONIC MATERIALS USA CORP.
ATTENTION: INDUSTRIAL PROPERTY DEPT.
70 MEISTER AVENUE
SOMERVILLE, NJ 08876

EXAMINER	
LE, HOA VAN	

ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
11/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,997	NAGAHARA ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This application is up for consideration.

A. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Lack of Unity Requirement
Claims 1-20 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2
PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a general inventive concept (requirement of unity of invention).
PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.
Annex B, Part I(b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.
Annex B, Part I(e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:.
(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said

product, and an independent claim for a use of the said product, or
(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specifically designed for carrying out the said process .... "

For the same technical concepts of the unity of the invention, it is also applied to unity of species. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a singly patentable non-unity or distinct species. Otherwise, all species of the broadly claimed compound contain a hydrophilic group as at least some of being specified as:

lauryldimethylamineoxide, lauryl amidepropylamineoxide, triethylamineoxide, O←N(CH3)2-(CH2)12-(CH3)2N--)O, disodium lauryl sulfosuccinate, sodium dodecylbenzenesulfonate, sodium lauroylsarcosine, sodium laurylsulfate, triethanolamine laurylsulfate, ammonium laurylsulfate, sodium polyoxyethylene alkyl ether sulfates, ammonium laurate, sodium laurate, sodium palmitate, potassium stearate, and ammonium oleate, and salts of acylated amino acids, sodium, potassium, ammonium, triethanolamine salts of alkylphosphoric acids, polyoxyethylene alkyl ether phosphoric acids, and polyoxyethylene alkylphenyl ether phosphoric acids are considered as unity species and are not patentably different or distinct.

Accordingly, no separate consideration or search will be made for any one the

specific patentably distinct compounds. A separate argument for any one of the non-unity or patentably different or distinct species will not be considered. They will stand or fall together.

At least multiple patentably distinct or non-unity species being able to specifically define are: Each of the species of lauryl dimethylamineoxide, lauryl amidepropylamineoxide, triethylamineoxide, O←N(CH3)2-(CH2)12-(CH3)2N--)O, disodium lauryl sulfosuccinate, sodiumdodecylbenzenesulfonate, sodium lauroylsarcosine, sodium laurylsulfate, triethanolamine laurylsulfate, ammonium laurylsulfate, sodium polyoxyethylene alkyl ether sulfates, ammonium laurate, sodium laurate, sodium palmitate, potassium stearate, and ammonium oleate, and salts of acylated amino acids, sodium, potassium, ammonium, triethanolamine salts f alkylphosphoric acids, polyoxyethylene alkyl ether phosphoric acids, and polyoxyethylene alkylphenyl ether phosphoric acids does not share obviously about the same chemical structure as being an obvious variant to one having ordinary skill in the art at the time the invention was made.

The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to **elect a single disclosed distinct specie from one of the group of** lauryl dimethylamineoxide, lauryl amidepropylamineoxide, triethylamineoxide, O←N(CH3)2-(CH2)12-(CH3)2N--)O, disodium lauryl sulfosuccinate, sodiumdodecylbenzenesulfonate, sodium lauroylsarcosine, sodium laurylsulfate, triethanolamine laurylsulfate, ammonium laurylsulfate, sodium polyoxyethylene alkyl ether sulfates, ammonium laurate, sodium laurate, sodium palmitate, potassium stearate, and ammonium oleate, and salts of acylated amino acids, sodium, potassium, ammonium, triethanolamine salts f alkylphosphoric acids, polyoxyethylene alkyl ether phosphoric acids,

and polyoxyethylene alkylphenyl ether phosphoric acids for an initially searching steps in a prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species,** including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

However, applicants may and should disagree and state on and for the record that there is no non-unity or patentably different or distinct species since the species are an obvious variant to one having ordinary skill in the art at the time the invention was made. They stand or fall together. Therefore, no separate consideration or search is requested and required. **If there is no proper election in response to this Office action, no specific species will be considered or searched. No argument to a non-unity or patentably**

different or distinct species will be considered. It is now notified for the record.

Upon the allowance of a generic claim, **especially claim 1**, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

B. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence

now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

C. Other issues have not been considered until a timely and proper election is made and resolved.

D. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
02 November 2007

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le